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IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Attorney Docket No.: Poly-32

Appl. No.: 09/941,072

Appellants: David GOODMAN et al.

Filed: August 28, 2001

Title: TRACKING FILES OF STORAGE MEDIA AND ENABLING USERS TO
QUICKLY ASSOCIATE SUCH FILES WITH THE STORAGE MEDIA ON
WHICH THEY ARE STORED

TC/A.U.: 2161

Examiner: Etienne Pierre Leroux

Mail Stop Appeal Brief
Commissioner for Patents
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APPEAL BRIEF

Further to the Notice of Appeal filed on January 3, 2007,
which set a period for response to expire on March 3, 2007,
that period being extended four (4) months to expire on July
3, 2007, the appellants request that the Board reverse all
outstanding grounds of rejection in view of the following.

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I. Real Party In Interest

The real party in interest is Polytechnic University. An assignment of the above-referenced patent application from the inventors to Polytechnic University was recorded in the Patent Office starting at Frame 0254 of Reel 012130.

II. Related Appeals and Interference

There are no related appeals or interferences.

III. Status of Claims

Claims 1-43 are pending.

Claims 1-43 are rejected. Specifically, claims 1-14 are rejected under 35 U.S.C. 112, first paragraph. Claims 1-8, 10-15, 19-27, 29-35 and 39-42 are rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,483,602 ("the Haneda patent"). Claims 9 and 28 are rejected under 35 U.S.C. § 103 as being unpatentable over the Haneda patent in view of U.S. Patent No. 4,864,616 ("the Pond patent"). Claims 16-18 and 36-38 are rejected under 35 U.S.C. § 103 as being unpatentable over the Haneda patent in view of U.S. Patent No. 5,971,279 ("the Raistrick patent"). Finally, claim 43 is rejected under 35 U.S.C. § 103 as being unpatentable over the Haneda patent.

The foregoing rejections of claims 1-43 are appealed.

IV. Status of Amendments

There have been no amendments subsequent to the final Office Action (Paper No. 8/24/06).

V. Summary of the Claimed Subject Matter

One aspect of the present invention concerns a computer implemented method (and apparatus) for use by a read/write machine, for assigning a unique label to a storage medium. In particular, the method recited in claim 1 includes determining whether or not the storage medium has been assigned a unique volume label and a unique storage medium label, the unique storage medium label uniquely identifying the storage medium (This is supported, for example, by Figure 3, 310; Figure 6; page 16, line 32 through page 17, line 30; and page 25, line 8 through page 26, line 8.) If the storage medium has not been assigned a unique volume label and a unique storage medium label, then the method determines a unique storage medium label for the storage medium (This is supported, for example, by Figure 3, 315; page 17 line 30 through page 18, line 3; and page 26, lines 6-17.), determines a unique volume label for the storage medium (This is supported, for example, by Figure 3, 315; Figure 6, 670b; page 17, line 30 through page 18, line 3; and page 19, lines 1-14.), writes the unique volume label onto the storage medium (This is supported, for example, by Figure 3, 320; Figure 6, 670b; page 18, lines 3-14; and page 26, lines 17-22.), and provides a command to generate a label based on the unique storage medium label, the label to be associated with the storage medium (This is supported, for example, by Figure 3, 325; Figure 6, 670a and 680; page 18, lines 3-11; and page 26, lines 12-17.). Finally, the method

updates a database based on files, if any, added to or deleted from the storage medium. (This is supported, for example, by Figure 3, 330; Figure 6, 650 and 660; page 18, lines 14-16; and page 26, lines 2-4.)

Corresponding independent apparatus claim 20 recites an apparatus for assigning a unique label to a removable storage medium (This is supported, generally, by Figure 1; page 8, lines 5-24; Figure 2; page 15, lines 1-32; Figure 5; and page 22, line 26 through page 23, line 17.), the apparatus comprising (a) means for reading files from and/or writing files to a removable storage medium (This is supported, for example, by Figure 1, 114 and 16; Figure 2, 216 and 218; and page 10, line 18 through page 11, line 16.); (b) means for generating a label (This is supported, for example, by Figure 2, 224 and 226; page 10, lines 25-29; and page 15, lines 13-17.); (c) means for determining whether or not the removable storage medium has been assigned a unique volume label and a unique storage medium label, the unique storage medium label uniquely identifying the storage medium (This is supported, for example, by Figure 2, 214 and 216; and page 11, lines 5-14.); (d) means, if the storage medium has not been assigned a unique volume label and a unique storage medium label, for (i) determining a unique storage medium label, (ii) determining a unique volume label, (iii) instructing the means for reading and/or writing files to write the unique volume label onto the storage medium, and (iv) providing a command to generate a label based on the unique storage medium label, to the means for generating a label (This is supported, for example, by Figure 2, 214 and 216; and page 11, lines 5-14.); and (e) a database, wherein the database is updated based on any files added to or deleted from the removable storage medium (This is supported, for example, by Figure 2, 220 and

222; page 10, lines 18-25; and page 11, line 18 through page 12, line 11.).

In at least some embodiments, such as that recited in dependent claim 10, the method may further (d) accept information read from a label associated with the storage medium without reading the storage medium (This is supported, for example, by Figure 4, 410 and 415; Figure 8, 830; page 20, lines 15-21; and page 28, lines 3-15.), (e) convert the accepted information into a database key (This is supported, for example, by Figure 4, 420; Figure 8, 840; page 20, lines 25-32; and page 28, lines 15-18.), (f) request records from a database instance using the database key (This is supported, for example, by Figure 4, 425; Figure 8, 850; page 20, line 32 through page 21, line 3; and page 28, lines 18-21.), (g) accept records in response to the request (This is supported, for example, by Figure 4, 425; Figure 8, 860 and 870; page 20, line 32 through page 21, line 3; and page 28, lines 21-31.), and (h) render information about the accepted records (This is supported, for example, by Figure 4, 430; Figure 8, 880; page 20, lines 3-5; and page 28, lines 31 and 32.).

Corresponding apparatus claim 29 recites (f) means for reading a label associated with the storage medium without reading the storage medium (This is supported, for example, by Figure 2, 252; and page 12, lines 13-25.); (g) means for accepting information read, by the means for reading, from a label associated with the storage medium (This is supported, for example, by Figure 2, 242 and 252; page 12, line 13-25; and page 13, lines 3-8.); (h) means for converting the read label into a database key (This is supported, for example, by Figure 2, 254; page 12, lines 13-25; and page 13, lines 3-8.); (i) means for requesting records from a database instance

using the database key (This is supported, for example, by Figure 2, 254; page 12, lines 13-25; and page 13, lines 3-8.); (j) means for accepting records in response to the request (This is supported, for example, by Figure 2, page 12, lines 13-25; and page 13, lines 3-8.); and (k) means for rendering information about the accepted records (This is supported, for example, by Figure 2, 248; page 12, lines 13-25 and page 13, lines 8-11.). These elements are generally supported, for example, by Figure 1; page 8, lines 5-24; Figure 2; page 15, lines 1-32; Figure 5; and page 22, line 26 through page 23, line 17.

Another aspect of the present invention concerns a computer implemented method (or apparatus) for use by a read/write machine, for matching file parameters with one or more storage media, each of the one or more storage media having an associated label. In particular, the method recited in independent claim 15 includes (a) accepting one or more search parameters selected from a group of parameters consisting of (A) file name, (B) file size, (C) file author, and (D) file type (This is supported, for example, by Figure 4, 440 and 445; Figure 9, 930 and 940; page 21, lines 19-23; and page 29, lines 4-18.), (b) generating a query based on the search parameters (This is supported, for example, by Figure 4, 450; Figure 9, 950; page 21, line 29-32; and page 29, lines 18-20.), (c) accepting one or more records returned in response to the query generated (This is supported, for example, by Figure 4, 455; Figure 9, 960; page 22, lines 2-5; and page 29, lines 21-27.), and (d) rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified

with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium (This is supported, for example, by Figure 4, 460; page 22, lines 5-8; and page 29, line 27 through page 30, line 7.).

In some embodiments (See dependent claims 16 and 17.), the labels are machine-readable labels, and the method further (e) accepts information read from the machine-readable labels (This is supported, for example, by page 22, lines 8-11.); (f) generates a first indicator, said first indicator able to be perceived by humans, if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted (This is supported, for example, by page 22, lines 11-13 and page 30, lines 2-7.), and (g) generates a second indicator, said second indicator able to be perceived by humans, if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted (This is supported, for example, by page 22, lines 11-13 and page 30, lines 2-7.). Corresponding apparatus claims 36 and 37 are supported by the foregoing sections, and are generally supported, for example, by Figure 1; page 8, lines 5-24; Figure 2; page 15, lines 1-32; Figure 5; and page 22, line 26 through page 23, line 17.

Corresponding apparatus claim 35 recites an apparatus (This is generally supported, for example, by Figure 1; page 8, lines 5-24; Figure 2; page 15, lines 1-32; Figure 5; and page 22, line 26 through page 23, line 17.) for matching file parameters with one or more storage media, each of the one or more storage media having an associated label. The apparatus includes (a) a user input for accepting one or more search parameters selected from a group of parameters consisting of

(A) file name, (B) file size, (C) file author, and (D) file type (This is supported, for example, by Figure 2, 246; and page 13, lines 15-19.); (b) means for generating a query based on the accepted one or more search parameters (This is supported, for example, by Figure 2; and page 13, lines 19-22.); (c) means for accepting one or more records returned in response to the query generated (This is supported, for example, by page 13, lines 19-22.); and (d) means for rendering information associated with each of the one or more records accepted, the information rendered being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium (This is supported, for example, by Figure 2, 248; and page 13, lines 22-29.).

To summarize the foregoing, various embodiments of the present invention may be used to (i) associate a label, such as a bar code label, with a storage medium and (ii) associate the label with the contents of the storage medium. In this way, given a storage medium, a user can determine its contents, without needing to read the storage medium, by reading the label. Similarly, given a file, a user can determine the label of the storage medium on which the file is stored. The labels of various storage media can be quickly read, and an indication of whether or not the storage medium includes the file can be provided to a user.

VI. Grounds of Rejection to be Reviewed on Appeal

The issues presented for review are whether:

(1) (separately patentable and argued groups of) claims 1-14 comply with the enablement requirement under 35 U.S.C. 112, first paragraph;

(2) (separately patentable and argued groups of) claims 1-8, 10-15, 19-27, 29-35 and 39-42 are anticipated by U.S. Patent No. 6,483,602 ("the Haneda patent");

(3) claims 9 and 28 are rendered obvious by the Haneda patent in view of U.S. Patent No. 4,864,616 ("the Pond patent");

(4) (separately patentable and argued groups of) claims 16-18 and 36-38 are rendered obvious by the Haneda patent in view of U.S. Patent No. 5,971,279 ("the Raistrick patent"); and

(5) claim 43 is rendered obvious by the Haneda patent.

VII. Argument

The appellants respectfully request that the Board reverse the final rejection of claims 1-43 in view of the following.

Rejections under 35 U.S.C. § 112

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The appellants respectfully request that the Board reverse this ground of rejection in view of the following.

The Examiner contends that although claim 1 recites "determining whether or not the storage medium has been

assigned a unique value label and a unique label identifier," the specification does not include an enabling disclosure of this feature. (Paper No. 8/24/06, page 2.) The Examiner also contends that the specification did not enable making and using a "unique storage medium label". (Paper No. 8/24/06, page 2.) The Examiner interpreted the claimed unique volume label and the claimed unique storage medium label as being one in the same thing. (Paper No. 08/24/06, page 3.)

The teachings of the specification, as they would be understood by one skilled in the art, as well as relevant case law, are now introduced.

MPEP § 2164.01 correctly notes that the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent, coupled with information known in the art, without undue experimentation. One skilled in the art could determine whether or not the storage medium has been assigned a unique volume label and a unique label identifier (or a unique storage medium label) without undue experimentation in light of the teachings of the specification, the level of skill in the art, and the predictable nature of data storage.

It is assumed that those skilled in the art would have knowledge of various storage medium operations, such as reading, writing, formatting, etc. It is further assumed that such operations are predictable. As for the specification, it states, in pertinent part:

Basically, *when files are first written to a machine-readable medium 218, the content tracking base operation(s) 212 will, based on state information 264, associate a unique identifier (and a unique volume label) with the machine-readable medium 218.* Further, when files are first

written to the machine-readable medium 218, the content tracking base operation(s) 212 will also provide unique information to the label generation operation(s) 224 for having the printer 226 generate a label (such as a bar code label for example) 228. In alternative embodiments, other types of machine-readable labels can be generated instead. [Emphasis added.]

Page 11, lines 5-16.

In the following, the term "unique volume label" uniquely identifies a storage medium, and may be **written onto the storage medium**. Therefore, if the storage medium is a diskette, the unique volume label may be a unique label written onto the diskette by a floppy disk drive, and that may be subsequently read by a floppy drive. The term "label" **also uniquely identifies a storage medium, but is associated with (e.g., affixed to) the storage medium**. Therefore, if the storage medium is a diskette, the label may be a bar code label affixed to the case of the diskette, and that may be subsequently read by a bar code reader. Although the unique volume label, and the label of a given storage medium may be the same, or encode the same information, this is not necessarily the case.

Referring back to conditional branch point 310, recall that **it is determined whether or not a storage medium is new. This may be done, for example, by comparing the unique volume label, if any, of the storage medium, with stored state information** (Recall, e.g., 264 of Figure 2.). **If the storage medium is determined to be new, the method 212' continues to block 315 where a unique label and a unique volume label are determined.** For example, these labels may be determined from state information 264, such as a counter that is incremented for each new storage medium for example. Then, as indicated by blocks 320

and 325, the unique volume label is written onto the storage medium, and a command to print (or otherwise generate) a unique label associated with the storage medium is generated. Referring back to Figure 2, this command may be passed to the label generation operation 224. The user may then associate the printed unique label with the storage medium (e.g., by affixing it to a so-called "jewel-box" case or cartridge used to hold the storage medium). Alternatively, the unique label may be automatically associated with the storage medium (i.e., without (further) user intervention) in another way. As indicated by block 330, the database may be updated to reflect saved or deleted files. For example, this may be done by adding a new record (or item), or by altering an appropriate existing record (or item), when a file is saved, or by removing an appropriate record (or item) when a file is deleted. The key of the record (or item) may correspond to that used for the unique label, or the unique volume label, though this is not necessarily true. As indicated by optional block 335, a synchronization may be effected (Recall, e.g., operations 262 and 258 of Figure 2.) if possible. The method 212' may then be left via RETURN node 360.

Referring back to conditional branch point 310, if the storage medium is determined not to be new, the method 212' continues to block 330, which was just described above.

Naturally, there are many ways to assign unique volume labels. One exemplary way is to maintain a sequence count which may be initialized (e.g., to "1000") when the content tracking application is installed onto the read/write machine (e.g., a personal computer). The unique volume label may be written by launching a DOS command such as "label a: {sequence count value}" within a JAVA application. When

determining whether a current disk has a valid unique volume label, the (unique) volume label can be read and compared with the sequence count. If the read (unique) volume label is greater than the value of the sequence count (or less than the value of the initial sequence count), or is not an x-digit (e.g., 4-digit) number, then it may be deemed invalid.

Page 17, line 10 through page 19, line 14.

Assigning and tracking one or more unique identifiers for each of a plurality of storage mediums is certainly practicable by those skilled in the art. More specifically, as can be appreciated from the foregoing excerpts, the first time files are written to a storage medium, a "unique volume label" might be written onto the storage medium and a "label" might be associated with (e.g., affixed to) the storage medium. The "label" is obviously generated from some data. The appellants chose to call this a "unique label identifier". (MPEP § 2173.01 correctly notes that appellants are their own lexicographers and may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought.)

Since both the unique storage medium label and unique volume label are determined when the storage medium has not been assigned a unique volume label and a unique storage medium label, the absence of either or both of these from a storage medium can be used to indicate the storage medium has not been assigned a unique volume label and a unique storage medium label. Since determining whether or not a storage medium includes a volume label can be accomplished by those skilled in the art, it follows logically that those skilled in the art can determine whether or not the storage medium has

not been assigned a unique volume label and a unique label identifier. Consequently, the rejection under 35 U.S.C. § 112, paragraph 1 is improper and should be withdrawn.

As can be appreciated from the foregoing excerpts, the unique storage medium label uniquely identifies the storage medium.

As can be appreciated from the foregoing, claim 1 is enabled. Consequently, the appellants respectfully request that the Board reverse this ground of rejection of claim 1, as well as of dependent claims 2-14.

In the final Office Action, the Examiner cites paragraph [0071] of the present application which discusses scanning a storage medium label and asserts that it is unclear how a user scans a non-existent label. (See Paper No. 08/24/06, page 12.) The "show contents" example cited by the Examiner occurs after the label has been added. Consequently, the part of the specification cited by the Examiner is not relevant to the issue of enablement. The fact that the Examiner can cite a section of the specification not relevant to the issue of enablement does not negate the fact that the appellants has demonstrated that (relevant portions of) the specification enables those skilled in the art to make and use the claimed invention.

Rejections under 35 U.S.C. § 102

Claims 1-8, 10-15, 19-27, 29-35 and 39-42 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the Haneda patent. The appellants respectfully request that the Board reverse this ground of rejection in view of the following.

Before addressing at least some of the patentable features of these claims, the Haneda patent is first

introduced. The Haneda patent concerns a film image management system. Referring to Figure 10 of the Haneda patent, undeveloped film is developed and read, and image information is saved to a laboratory disk, printed, and recorded (perhaps in reduced form) on a user disk. Labels with an identification code may be printed and affixed to one or both of a film roll container or envelope, and the user disk. (See, e.g., Figures 3-7.)

In addition to, or instead of, affixing the bar code label to the disk, the identification code may be stored on the disk. Examples of the identification code are listed on column 15, lines 14-48. The label may be provided with human comprehensible characters, symbols, and/or figures. (See, e.g., Figures 8 and 9.)

Note that the media contents of the developed film, to which an identification code label is applied, are fixed. Similarly, the media contents of the user disk, to which an identification code label is applied, are intended to be fixed.

The identification code and frame identifiers may be used when ordering extra prints (e.g., via a communications network or via a paper order form). For example, such extra prints may be ordered while the user is viewing the images using a playback program. Specifically, the laboratory can use the identification code and frame identifier to retrieve images that the user wants extra prints of. (See, e.g., column 5, lines 29-42.)

Having introduced the Haneda patent above, at least some patentable features of the claims are now discussed.

Group I: Claims 1-8, 10-12, 20-27, 29-34, 40 and 41

Independent claims 1 and 20 are not anticipated by the Haneda patent because the Haneda patent does not teach an act of (or means for) determining whether or not the storage medium has been assigned a unique volume label and a unique storage medium label (the unique storage medium label uniquely identifying the storage medium), and if the storage medium has not been assigned a unique volume label and a unique storage medium label, then determining **both** a unique storage medium label for the storage medium, **and** a unique volume label for the storage medium, writing the unique volume label onto the storage medium, and providing a command to generate a label based on the unique storage medium label, the label to be associated with the storage medium.

In the rejection of claims 1-14 under 35 U.S.C. § 112, first paragraph, the Examiner noted that he would assume that the unique volume label and the unique storage medium label are one and the same thing. See Paper No. 08/24/06, page 3. In the rejection of these claims as being anticipated under the Haneda patent, the Examiner cites column 4, lines 8-15, as well as column 19, lines 50-65 (See Paper No. 08/24/06, page 4.), which describes storing an identification code on film, a user recording medium, and a laboratory recording medium, and affixing a bar code label to developed film and perhaps the user's disk as teaching this feature which describes

The appellants respectfully, but strongly submit that the Examiner is improperly ignoring features of the claimed invention which distinguish it over the Haneda patent. Specifically, merely affixing or storing an identification code to a storage medium does not teach **determining whether or not the storage medium has been assigned** a unique volume label

and a unique storage medium label (the unique storage medium label uniquely identifying the storage medium). As discussed above, in the Haneda patent, undeveloped film is developed and read, and image information is saved to a laboratory disk, printed, and recorded (perhaps in reduced form) on a user disk. Labels with an identification code may be printed and affixed to one or both of a film roll container or envelope, and the user disk. Note that the media contents of the developed film to which an identification code label are fixed. Similarly, the media contents of the user disk to which an identification code label are intended to be fixed. ***That is, the user disk is intended to be written with reduced or original sized images, and perhaps the identification code, once. Consequently, there would be no need to determine whether or not this has been written on the user disk -- when the laboratory first stores the image data on the user disk, such information has not already been written and/or applied to the disk.***

Independent claims 1 and 20 are not anticipated by the Haneda patent for at least the foregoing reason. Since claim 2-8, 10-12 and 40 depend, either directly or indirectly, from claim 1, and since claims 21-27, 29-34 and 41 depend, either directly or indirectly, from claim 20, these claims are similarly not anticipated by the Haneda patent.

Group II: Claims 13 and 14

First, since claim 13 depends, indirectly, from claim 1, it is not anticipated by the Haneda patent for at least the reason discussed above (See Group I.) with reference to claim 1.

Also, dependent claim 13 further recites that accepted information read from a label associated with the storage medium is read by a handheld device, and the information about accepted records (accepted in response to a request from a database instance using a database key converted from the accepted information) is rendered on the handheld device. The Examiner cited paragraph 39 of the Haneda patent as teaching this feature. (See Paper No. 08/24/06, page 6.) However, the appellants have not found this feature in the Haneda patent, and previously requested that the Examiner cite the column and line numbers and/or Figure and reference numbers of the Haneda patent alleged to teach this feature. Nonetheless, the Examiner still only cited paragraph 39 of the Haneda patent. Thus, claim 13 is not anticipated by the Haneda patent for at least this additional reason.

Since claim 14 depends from claim 13, it is similarly not anticipated by the Haneda patent.

Group III: Claims 15, 19, 35, 39 and 42

Independent claims 15 and 35, as amended, are not anticipated by the Haneda patent because the Haneda patent does not teach an act of (or means for) accepting one or more search parameters selected from a group of parameters consisting of (A) file name, (B) file size, (C) file author, and (D) file type. The Examiner is apparently characterizing the album name in the Haneda patent as the claimed "file name". (See Paper No. 08/24/06, page 7, which cites column 54, lines 35-40.) The Examiner then cites column 4, lines 40-48, column 5, lines 25-30 and column 9, lines 45-60 as teaching rendering information associated with each of the one or more records accepted, the information rendered being

related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, wherein the label is provided on the storage medium without storing it on the storage medium. (See Paper No. 08/24/06, page 7.)

However, an album is a collection of image data from one or more rolls of film. (See, e.g., column 51, lines 63-65 and column 52, lines 40 and 41 of the Haneda patent.) If the album name is input in the Haneda patent, information associated with each of the one or more records accepted, and being related to the label associated with the storage medium storing one or more files identified with the one or more records accepted, is not rendered. Accordingly, independent claims 15 and 35 are not anticipated by the Haneda patent. Since claims 19 and 42 depend from claim 15, and since claim 39 depends from claim 35, these claims are similarly not anticipated by the Haneda patent.

Rejections under 35 U.S.C. § 103

Group IV: Claims 9 and 28

Claims 9 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Haneda patent in view of the Pond patent. The appellants respectfully request that Board reverse this ground of rejection in view of the following.

Since the purported teachings of the Pond patent fail to compensate for the deficiencies of the Haneda patent with respect to claims 1 and 20 as discussed above (See Group I), even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Pond references as proposed by the Examiner, such a combination would fail to

render the invention of claims 1 and 20, and therefore of claims 9 and 28, unpatentable.

Claims 16-18 and 36-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Haneda patent in view of the Raistrick patent. The appellants respectfully request that the Board reverse this ground of rejection in view of the following.

Group V: Claims 16 and 36

First, since the purported teachings of the Raistrick patent fail to compensate for the deficiencies of the Haneda patent with respect to claims 15 and 35 as discussed above (See Group III.), even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Raistrick patents as proposed by the Examiner, such a combination would fail to render the invention of claims 15 and 35, and therefore of claims 16 and 36, unpatentable.

Second, claims 16 and 36 further recite that the labels are machine-readable labels, and acts of (or means for) accepting information read from the machine-readable labels, and if the accepted information read from the machine-readable labels matches information associated with any one of the one or more records accepted, then generating a first indicator, said first indicator able to be perceived by humans. Under the scanning in the Raistrick patent, if a scanned bar code is found, an associated message is played, while if the scanned bar code is not found, a memo may be recorded. (See Figure 2, steps 64, 66 and 68, and column 4, lines 39-55.) Such an indication of whether or not a scanned bar code is found neither teaches, nor suggests, indicating whether or not a

scanned label affixed to a storage medium includes a file being searched for. Thus, the Raistrick patent does not teach what the Examiner alleges.

Furthermore, under the search operation in the Raistrick patent does not employ a bar code scan, but rather allows a user to move through (and perhaps erase) recorded memos. (See Figure 2, step 104 and column 5, lines 4-12.) Thus, the Raistrick patent does not teach what the Examiner alleges.

Moreover, the Raistrick patent is concerned with helping the visually impaired. One skilled in the art would not have been motivated to use such techniques in the context of an imaging system, such as that described in the Haneda patent, which uses thumbnails of images.

Thus, claims 16 and 36 are not rendered obvious by the Haneda and Raistrick patents for at least these additional reasons.

Group VI: Claims 17, 18, 37 and 38

First, since the purported teachings of the Raistrick patent fail to compensate for the deficiencies of the Haneda patent with respect to claims 15 and 35 as discussed above (See Group III.), even assuming, arguendo, that one skilled in the art would have been motivated to combine the Haneda and Raistrick patents as proposed by the Examiner, such a combination would fail to render the invention of claims 15 and 35, and therefore of claims 17, 18, 37 and 38, unpatentable. Similarly, since claims 17 and 37 depend from claims 16 and 36, respectively, and since claims 18 and 38 depend from claims 17 and 37, respectively, these claims are not rendered obvious by the Haneda and Raistrick patents for

at least the reasons discussed above (See Group IV.) with reference to claims 16 and 36.

Second, claims 17 and 37 further recite an act of (or means for) generating a second indicator, able to be perceived by humans, if the accepted information read from the machine-readable labels does not match information associated with any one of the one or more records accepted. As discussed above, under the scanning in the Raistrick patent, if a scanned bar code is found, an associated message is played, while if the scanned bar code is not found, a memo may be recorded. (See Figure 2, steps 64, 66 and 68, and column 4, lines 39-55.) Such an indication of whether or not a scanned bar code is found neither teaches, nor suggests, indicating whether or not a scanned label affixed to a storage medium includes a file being searched for. Thus, the Raistrick patent does not teach what the Examiner alleges.

Furthermore, under the search operation in the Raistrick patent does not employ a bar code scan, but rather allows a user to move through (and perhaps erase) recorded memos. (See Figure 2, step 104 and column 5, lines 4-12.) Thus, the Raistrick patent does not teach what the Examiner alleges.

Moreover, the Raistrick patent is concerned with helping the visually impaired. One skilled in the art would not have been motivated to use such techniques in the context of an imaging system, such as that described in the Haneda patent, which uses thumbnails of images.

Thus, claims 17, 18, 37 and 38 are not rendered obvious by the Haneda and Raistrick patents for at least these additional reasons.

Group VII: Claim 43

Claim 43 stands rejected under 35 U.S.C. § 103 as being unpatentable over the Haneda patent. The appellants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The Examiner takes official notice that updating a database based on files deleted from a storage medium is well-known and that implementing this into the Haneda patent would have been obvious to those skilled in the art. The Examiner's motivation to combine the purported well-known database update is that it would make searching simpler by eliminating from the database directory, files that have been deleted. (See Paper No. 142006, page 11.)

First, even assuming, *arguendo*, that updating a database based on files deleted from a storage medium is well-known, and further assuming, *arguendo*, that one skilled in the art would have been motivated to combine this purported knowledge into the Haneda patent as proposed by the Examiner, claim 1 would still not be rendered obvious for the reasons discussed above (See Group I.). Since claim 43 depends from claim 1, it would similarly be non-obvious.

Second, even assuming, *arguendo*, that updating a database based on files deleted from a storage medium is well-known, the Haneda patent does not contemplate changing the image data written to the user disk. That is, it is not contemplated that the user will delete such image data from the user disk. Moreover, the laboratory storage is apparently intended to be an archival storage (and is not provided with both a unique volume label and a unique storage medium label, the unique storage medium label uniquely identifying the storage medium), and consequently, image file deletion from laboratory storage

is also not contemplated. Accordingly, there would be no motivation to combine the purportedly well-known act of updating a database based on files deleted from a storage medium into the system described in the Haneda patent. Accordingly, claim 43 is not rendered obvious by the Haneda patent for at least this additional reason.

XIII. Claims appendix

An appendix containing a copy of the claims on appeal is filed herewith.

IX. Evidence appendix

There is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, nor is there any other evidence entered by the Examiner and relied upon by the appellants in the appeal.

X. Related proceedings appendix

There are no decisions rendered by a court of the Board in any proceeding identified in section II above pursuant to 37 C.F.R. § 41.38 (c) (1) (ii).

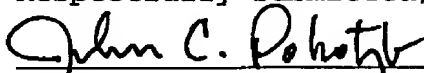
Conclusion

In view of the foregoing, the appellants respectfully submit that the pending claims are in condition for allowance. Accordingly, the appellants request that the Board reverse each of the outstanding grounds of rejection.

Any arguments made in this Appeal Brief pertain **only** to the specific aspects of the invention **claimed**. Any arguments are made **without prejudice to, or disclaimer of**, the appellant's right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Respectfully submitted,

July 3, 2007

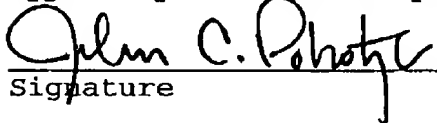

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CERTIFICATE OF FACSIMILE TRANSMISSION

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**CLAIMS APPENDIX PURSUANT TO
37 C.F.R. § 41.37 (c) (1) (viii)**

1 Claim 1 (previously presented): For use by a read/write
2 machine, a method for assigning a unique label to a storage
3 medium, the method comprising:
4 a) determining whether or not the storage medium has
5 been assigned a unique volume label and a unique
6 storage medium label, the unique storage medium label
7 uniquely identifying the storage medium;
8 b) if the storage medium has not been assigned a
9 unique volume label and a unique storage medium label,
10 then
11 (i) determining a unique storage medium label
12 for the storage medium,
13 (ii) determining a unique volume label for the
14 storage medium,
15 (iii) writing the unique volume label onto the
16 storage medium, and
17 (iv) providing a command to generate a label
18 based on the unique storage medium label, the
19 label to be associated with the storage medium;
20 and
21 c) updating a database based on files, if any, added
22 to or deleted from the storage medium.

1 Claim 2 (original): The method of claim 1 further
2 comprising:
3 d) synchronizing the database with a database on a
4 device apart from the read/write machine.

1 Claim 3 (original): The method of claim 2 wherein the
2 read/write machine is a personal computer and the device is
3 a handheld device.

1 Claim 4 (original): The method of claim 3 wherein the
2 device is an untethered handheld device.

1 Claim 5 (original): The method of claim 1 wherein the
2 read/write machine is a computer with at least one of (a) a
3 floppy disk drive, (b) a CD ROM drive, (c) a ZIP drive, and
4 (d) a DVD drive.

1 Claim 6 (previously presented): The method of claim 1
2 wherein the label based on the unique storage medium label
3 is a bar code label.

1 Claim 7 (original): The method of claim 1 wherein the act
2 of determining a unique volume label is based, at least in
3 part, on state information accessible to the read/write
4 machine.

1 Claim 8 (original): The method of claim 7 wherein the
2 state information is a count sequence.

1 Claim 9 (original): The method of claim 1 wherein the
2 database includes records, each record including a first
3 field having a value associated with the unique volume
4 label, and a second field having a value associated with a
5 file stored on the storage medium.

1 Claim 10 (previously presented): The method of claim 1,
2 further comprising:
3 d) accepting information read from a label associated
4 with the storage medium without reading the storage
5 medium;
6 e) converting the accepted information into a
7 database key;
8 f) requesting records from a database instance using
9 the database key;
10 g) accepting records in response to the request; and
11 h) rendering information about the accepted records.

1 Claim 11 (original): The method of claim 10 wherein the
2 label associated with the storage medium is a bar code and
3 wherein the information read from the label is accepted
4 from a bar code scanner.

1 Claim 12 (original): The method of claim 10 wherein the
2 information about the accepted records rendered includes
3 file names.

1 Claim 13 (original): The method of claim 12 wherein the
2 accepted information read from a label associated with the
3 storage medium is read by a handheld device, and the
4 information about the accepted records is rendered on the
5 handheld device.

1 Claim 14 (original): The method of claim 13 wherein the
2 read label is converted into a database key by the handheld
3 device, the records are requested from a database instance
4 using the database key by the handheld device, and the

5 records are accepted in response to the request by the
6 handheld device.

1 Claim 15 (previously presented): A method for matching
2 file parameters with one or more storage media, each of the
3 one or more storage media having an associated label, the
4 method comprising:

- 5 a) accepting one or more search parameters selected from
6 a group of parameters consisting of (A) file name, (B)
7 file size, (C) file author, and (D) file type;
- 8 b) generating a query based on the search parameters;
- 9 c) accepting one or more records returned in response to
10 the query generated;
- 11 d) rendering information associated with each of the one
12 or more records accepted, the information rendered being
13 related to the label associated with the storage medium
14 storing one or more files identified with the one or more
15 records accepted, wherein the label is provided on the
16 storage medium without storing it on the storage medium.

1 Claim 16 (original): The method of claim 15 wherein the
2 labels are machine-readable labels, the method further
3 comprising:

- 4 e) accepting information read from the
5 machine-readable labels;
- 6 f) if the accepted information read from the
7 machine-readable labels matches information associated
8 with any one of the one or more records accepted, then
9 generating a first indicator, said first indicator
10 able to be perceived by humans.

1 Claim 17 (original): The method of claim 16 further
2 comprising:

3 g) if the accepted information read from the
4 machine-readable labels does not match information
5 associated with any one of the one or more records
6 accepted, then generating a second indicator, said second
7 indicator able to be perceived by humans.

1 Claim 18 (original): The method of claim 17 wherein the
2 first indicator is a first audible sound, and the second
3 indicator is a second audible sound.

1 Claim 19 (original): The method of claim 15 wherein each
2 of the labels include human-readable part, and wherein the
3 information associated with each of the one or more records
4 accepted corresponds to the human-readable part of the
5 labels.

1 Claim 20 (previously presented): An apparatus for
2 assigning a unique label to a removable storage medium, the
3 apparatus comprising:
4 a) means for reading files from and/or writing files
5 to a removable storage medium;
6 b) means for generating a label;
7 c) means for determining whether or not the removable
8 storage medium has been assigned a unique volume label
9 and a unique storage medium label, the unique storage
10 medium label uniquely identifying the storage medium;
11 d) means, if the storage medium has not been assigned
12 a unique volume label and a unique storage medium
13 label, for

14 (i) determining a unique storage medium label,
15 (ii) determining a unique volume label,
16 (iii) instructing the means for reading and/or
17 writing files to write the unique volume label
18 onto the storage medium, and
19 (iv) providing a command to generate a label
20 based on the unique storage medium label, to the
21 means for generating a label; and
22 e) a database, wherein the database is updated based
23 on any files added to or deleted from the removable
24 storage medium.

1 Claim 21 (original): The apparatus of claim 20 further
2 comprising:

3 f) means for synchronizing the database with a
4 database on a device apart from the apparatus.

1 Claim 22 (original): The apparatus of claim 21 wherein the
2 device is a handheld device.

1 Claim 23 (original): The apparatus of claim 21 wherein the
2 device is an untethered, handheld device.

1 Claim 24 (original): The apparatus of claim 20 wherein the
2 means for reading files from and/or writing files to a
3 removable storage medium are at least one of (a) a floppy
4 disk drive, (b) a CD ROM drive, (c) a ZIP drive, and (d) a
5 DVD drive.

1 Claim 25 (original): The apparatus of claim 20 wherein the
2 label is a bar code label.

1 Claim 26 (original): The apparatus of claim 20 further
2 comprising:
3 f) state information, wherein the unique volume label
4 is determined, at least in part, based on the state
5 information.

1 Claim 27 (original): The apparatus of claim 26 wherein the
2 state information is a count sequence.

1 Claim 28 (original): The apparatus of claim 20 wherein the
2 database includes records, each record including a first
3 field having a value associated with the unique volume
4 label, and a second field having a value associated with a
5 file stored on the removable storage medium.

1 Claim 29 (previously presented): The apparatus of claim 20
2 further comprising:
3 f) means for reading a label associated with the
4 storage medium without reading the storage medium;
5 g) means for accepting information read, by the means
6 for reading, from a label associated with the storage
7 medium;
8 h) means for converting the read label into a
9 database key;
10 i) means for requesting records from a database
11 instance using the database key;
12 j) means for accepting records in response to the
13 request; and
14 k) means for rendering information about the accepted
15 records.

1 Claim 30 (original): The apparatus of claim 29 wherein the
2 means for reading is a bar code scanner, and wherein the
3 label associated with the storage medium is a bar code.

1 Claim 31 (original): The apparatus of claim 29 wherein the
2 information about the accepted records rendered includes
3 file names.

1 Claim 32 (original): The apparatus of claim 29 wherein the
2 means for rendering is a display.

1 Claim 33 (previously presented): The apparatus of claim 29
2 further comprising:
3 1) the database.

1 Claim 34 (previously presented): The apparatus of claim 33
2 further comprising:
3 m) means for synchronizing the database with a
4 database maintained by a separate machine which
5 created the storage medium.

1 Claim 35 (previously presented): An apparatus for matching
2 file parameters with one or more storage media, each of the
3 one or more storage media having an associated label, the
4 apparatus comprising:
5 a) a user input for accepting one or more search
6 parameters selected from a group of parameters consisting
7 of (A) file name, (B) file size, (C) file author, and (D)
8 file type;
9 b) means for generating a query based on the accepted
10 one or more search parameters;

11 c) means for accepting one or more records returned in
12 response to the query generated;
13 d) means for rendering information associated with each
14 of the one or more records accepted, the information
15 rendered being related to the label associated with the
16 storage medium storing one or more files identified with
17 the one or more records accepted, wherein the label is
18 provided on the storage medium without storing it on the
19 storage medium.

1 Claim 36 (original): The apparatus of claim 35 wherein the
2 labels are machine-readable labels, the apparatus further
3 comprising:

4 e) a label reader for reading information read from
5 the machine-readable labels; and
6 f) an output means for generating a first indicator
7 able to be perceived by humans if the accepted
8 information read from the machine-readable labels
9 matches information associated with any one of the one
10 or more records accepted.

1 Claim 37 (original): The apparatus of claim 36 wherein the
2 output means further generates a second indicator able to
3 be perceived by humans if the accepted information read
4 from the machine-readable labels does not match information
5 associated with any one of the one or more records
6 accepted.

1 Claim 38 (original): The apparatus of claim 37 wherein the
2 output means is a speaker, wherein the first indicator is a

3 first audible sound, and wherein the second indicator is a
4 second audible sound.

1 Claim 39 (original): The apparatus of claim 35 wherein
2 each of the labels include human-readable part, and wherein
3 the information associated with each of the one or more
4 records accepted corresponds to the human-readable part of
5 the labels.

1 Claim 40 (previously presented): The method of claim 1
2 wherein if the storage medium has not been assigned a
3 unique volume label and a unique storage medium label then
4 further,
5 - generating a label based on the unique storage
6 medium label, and
7 - fixing the generated label to the storage
8 medium without storing it on the storage medium.

1 Claim 41 (currently amended): The apparatus of claim 20
2 further comprising means, if the storage medium has not
3 been assigned a unique volume label and a unique storage
4 medium label, for
5 - generating a label based on the unique storage
6 medium label, and
7 - fixing the generated label to the storage
8 medium without storing it on the storage medium.

1 Claim 42 (previously presented): The method of claim 15
2 wherein the information rendered is related to the label
3 associated with the storage medium storing one or more
4 files identified with the one or more records accepted such

5 that a user or a scanner can distinguish the storage medium
6 including the label from other storage media.

1 Claim 43 (previously presented): The method of claim 1
2 further comprising:

3 d) updating the database based on files deleted from
4 the storage medium.

**EVIDENCE APPENDIX PURSUANT TO
37 C.F.R. § 41.37 (c) (1) (ix)**

There is no evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132, nor is there any other evidence entered by the Examiner and relied upon by the appellant in the appeal.

**RELATED PROCEEDINGS APPENDIX PURSUANT
TO 37 C.F.R. § 41.37 (c) (1) (x)**

There are no decisions rendered by a court of the Board in any proceeding identified in section II of the Substitute Supplemental Appeal Brief pursuant to 37 C.F.R. § 41.37 (c) (1) (ii).